

REMARKS

Applicant requests reconsideration and allowance of the present application in view of the foregoing amendments and the following remarks.

Claims 1, 5-9, 11, 12, 16, 18-20, 23, and 24 are pending in the present application. Claims 1, 7, 11, 12, 16, 20, 23, and 24 are the independent claims.

Claims 1, 7, 8, 11, 12, 16, 20, 23, and 24 have been amended. No new matter is believed to have been added.

Claims 1, 5, 6, 11, and 12 stand rejected under 35 U.S.C. § 112, second paragraph, as allegedly being indefinite. In response, Applicant has amended independent claims 1, 11 and 12 in view of the Examiner's comments and submits that these claims now even more fully satisfy the requirements of the second paragraph of 35 U.S.C. § 112.

Accordingly, favorable reconsideration and withdrawal of the rejection under 35 U.S.C. § 112 are respectfully requested.

Claims 1, 5-9, 11, 20, 23 and 24 stand rejected under 35 U.S.C. § 101 because the claimed invention is allegedly directed to non-statutory subject matter. Claims 1, 5, 6, 11, and 12 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Publication No. 2006/0212358 (Walker et al.) in view of Ying, and further in view of Szabo. Claims 7-9, and 23 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Walker et al. in view of Ying. Claims 16, 18-20, and 24 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Walker et al., Ying and Szabo. All rejections are respectfully reversed.

Regarding the rejection under 35 U.S.C. § 101, a proper analysis to determine whether a claim recites statutory subject matter includes the following four steps.

First, the Office must consider whether the claim falls within one of the four statutory categories set forth in 35 U.S.C. § 101, i.e., process, machine, manufacture, or composition of matter.

Second, the Office must next determine whether recited subject matter has been judicially excluded from patent protection because it includes an abstract idea, natural phenomenon, or law of nature. A claim that recites subject matter that falls within these three judicially-excluded areas is not patentable unless it recites some practical application or "tangible result" of the abstract idea, natural phenomenon, or law of nature. However, this preclusion does not apply if the claims do not include an abstract idea, natural phenomenon, or law of nature.

Third, if the subject matter recited has been judicially excluded, the Office must determine whether the claim recites a practical application. According to the interim guidelines, the requisite practical application can be shown in one of two ways: either the claimed process includes a physical transformation or it produces a useful, concrete, and tangible result. An example of a process resulting in a useful, concrete, and tangible result the Office cites the series of mathematical calculations resulting in a fixed share price suitable for recording and reporting in State Street Bank & Trust Co. v. Signature Financial Group Inc., 149 F.3d 1368 (Fed. Cir. 1998).

Fourth, the Office must determine whether the claim would effectively preempt use of the underlying abstract idea, law of nature, or natural phenomenon, despite the showing of a practical application. In this regard, the interim guidelines make clear that the use of a mathematical formula in combination with other steps in a process is statutory.

The rejection of claims 1, 5-9, 11, 20, 23 and 24 under 35 U.S.C. § 101 is traversed at least because these claims recite subject matter that falls into the enumerated categories of 35 U.S.C. § 101 and none of these claims recites subject matter excluded from patent protection, as discussed below. Specifically, none of claims 1, 5-9, 11, 20, 23 and 24 recites an abstract idea, natural phenomenon, or law of nature. Thus, the claims need not be amended to recite a tangible result.

Starting with the first step in the analysis, independent claims 1, 7, 11, 20, 23, and 24 each recite features of system for selling through a network. Indeed, attention is respectfully directed to the express recitations of these claims, which articulate a system with various units. Thus, the first step of the analysis is met because the claims fall within one of the four statutory categories (apparatus) set forth in 35 U.S.C. § 101.

Turning to the next step in the analysis, none of the claims recites subject matter that has been judicially excluded from patent protection. Indeed, none of claims 1, 5-9, 11, 20, 23 and 24 recite an abstract idea, natural phenomenon, or law of nature. In this regard, Applicant notes the absence of any such contention in the Office Action. Thus, the analysis ends with this second step because it is only a claim that recites subject matter that falls within these three judicially-excluded areas that require some practical application or “tangible result” of the abstract idea, natural phenomenon, or law of nature.

Applicant notes that the Office characterizes these claims as being directed to a “disembodied data structure.” Applicant also notes the erroneous characterization of claim 1 as

reciting "several sections" "which all represent mere program codes." This characterization is traversed. A review of independent claim 1, for example, reveals the following recitations:

a unit storage section configured to store a plurality of units ...; and
a detecting section configured to detect the number of elements to
be purchased

Thus, it is submitted that these units are not "mere program codes" as the Office Action alleges.

In sum, claims 1, 5-9, 11, 20, 23 and 24, which are directed to one of the four statutory categories set forth in 35 U.S.C. § 101, and do not do not recite an abstract idea, natural phenomenon, or law of nature, satisfy the requirements of 35 U.S.C. § 101.

Accordingly, favorable reconsideration and withdrawal of the rejection of claims 1, 5-9, 11, 19, 20, 23, and 24 under 35 U.S.C. § 101 are respectfully requested.

In the interest of compact prosecution, in the event that the Office maintains a rejection under 35 U.S.C. § 101, Applicant respectfully requests that the Office establish on the record a prima facie case by identifying, with specificity, how the subject matter that is alleged to be non-statutory can only be interpreted as "disembodied data structures," as required by U.S. Patent Laws and the Manual of Patent Examining Procedure.

Turning to the art rejections, each of the pending independent claims recites a system for selling elements of font sets. And, these elements are sold one by one.

The Office Action concedes that the primary citation to Walker does not disclose that the goods being sold by a system are "a variety of font sets." (Office Action, page 7). Nonetheless, the Office Action rejects the claims, relying on Ying to provide this necessary disclosure. (Id.)

The secondary citation to Ying discusses a system for selling font sets, which are sold one by one. A review of Ying, however, reveals an absence of any disclosure of goods being elements of font sets, as recited by the independent claims.

It is respectfully submitted that the tertiary citation to Szabo does not add anything that would remedy the aforementioned deficiency in the combination of Walker and Ying.

Accordingly, favorable reconsideration and withdrawal of the rejection under 35 U.S.C. § 103 are respectfully requested.

In view of the foregoing, Applicant respectfully submits that the independent claims patentably define the present invention over the citations of record. Further, the dependent

claims should also be allowable for the same reasons as their respective base claims and further due to the additional features that they recite. Separate and individual consideration of the dependent claims is respectfully requested.

Applicant believes that the present Amendment is responsive to each of the points raised by the Examiner in the Official Action. However, if there are any formal matters remaining after this response, the Examiner is requested to telephone the undersigned to attend to such matters.


There being no further outstanding objections or rejections, it is submitted that the present application is in condition for allowance. An early action to that effect is courteously solicited.

If there are any additional fees associated with filing of this Amendment, please charge the same to our Deposit Account No. 19-3935.

Respectfully submitted,

STAAS & HALSEY LLP

Date: 5-1-07

By: 
Michael E. Kondoudis
Registration No. 42,758

1201 New York Avenue, NW, 7th Floor
Washington, D.C. 20005
Telephone: (202) 434-1500
Facsimile: (202) 434-1501